

REMARKS/ARGUMENTS

Restriction/Election

The applicant affirms previous telephonic election of *Group I*, reading on *claims 1-25 without traverse*. Group II, reading on claim 26, was withdrawn.

35 USC § 102(b)

Claims 1-2, 4-16, and 21-25 were rejected under 35 USC § 102(b) as being anticipated by Edson (U.S. Pat. No. 4,585,539). The applicant respectfully disagrees, especially in view of the amendments herein.

With respect to amended claim 1 (and dependent claims 4-11), it is noted that amended claim 1 expressly requires that the first container "...has a first opening that that is configured to receive the catholyte and a second opening that is configured to discharge the catholyte after the catholyte has contacted the second container...", and that the first container "... is at least partially disposed in a tank that is configured to receive the catholyte from the second opening and that is configured to provide the catholyte to the first opening..." These elements are not taught or suggested by Edson. As amended claim 1 corresponds to allowable claim 3, amended claim 1 and dependent claims 4-11 should now be in condition for allowance.

With respect to amended claim 12 (and dependent claims 13-14), it should be noted that amended claim 12 expressly requires "...a flow velocity such that the flow velocity of the catholyte across the cathode plate provides a Reynolds number (Re) of above 2000..." and further requires a step of "...positioning the anode plate and the cathode plate relative to each other such that a flow path is formed between the anode plate and cathode plate from which the metal is deposited onto the cathode plate as a smooth film at non-current limiting conditions at the flow velocity..." These elements are not taught or suggested by Edson.

With respect to amended claim 21 (and dependent claims 22-25), it should be noted that the limitation of a metal in the electrolyte is not an intended use but a structurally distinguishable element of the device. The presence of that element in claim 21 is also not a manner of operating the device. Similarly, the recitation of the pump configuration is a structural limitation in terms

of the function performed, which should not be considered an intended use. Therefore, amended claim 21 should not be deemed anticipated by Edson.

35 USC § 103

Claims 1-2, 4-16, and 21-25 were also rejected under 35 USC § 103 as being anticipated by Edson in view of Frischauf et al. (WO 01/96631). The applicant again respectfully disagrees, especially in view of the amendments herein.

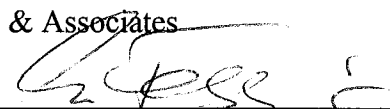
With respect to amended claim 1 (and dependent claims 4-11), it is noted that the claims now include all elements of allowable claim 3 and should thus be allowable. With respect to claims 12-16, it is noted that the cited references fail to teach all of the elements as presently claimed (see above). Thus, obviousness over these references cannot be properly established. Similarly, with further respect to amended claims 21-25, it is noted that the cited references fail to teach all of the elements as presently claimed (see above). Therefore, obviousness over these references cannot be properly established.

In view of the present amendments and arguments, the applicant believes that all claims are now in condition for allowance. Therefore, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Fish & Associates

By



Martin Fessenmaier, Ph.D.

Reg. No. 46,697

Tel.: (949) 253-0944